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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/467,368	12/20/1999	PETER KAMP HANSEN	4324.224-US	2312

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NEW YORK, NY 10110

EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 12/17/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/467,368

Applicant(s)

HANSEN ET AL.

Examiner

Manjunath N. Rao, Ph.D.

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 07 November 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 30-53.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 16.
10. ☐ Other: _____

Advisory Action

The request for reconsideration filed on 11-7-02 paper No.14 has been considered, but it does not place the application in condition for allowance because claims are now entirely directed to new subject matter, an animal feed, as opposed to the previous claims directed specifically to the xylanase enzyme. This raises new issues and requires the Examiner to do another search and also rewrite the rejections previously applied.

Furthermore, applicants continue to traverse the previous rejection of claims 30-53. Claims 30-40 were previously rejected under 35 U.S.C. 112, 1st paragraph as being too broad and non-enabled. In response to the above rejection applicants have traversed the above rejection arguing that the specification is fully enabled for practicing the applicants invention as presently directed to animal feeds. However, applicants argument against the rejection as applied to original claims 30-40 is silent on the breadth and non-enablement issues raised by the Examiner.

In response to the rejection of the above claims as lacking written description, applicants have traversed the rejection arguing that they have identified numerous sources for the xylanases and the skilled person, based on the general knowledge in the art and the information provided in the specification would be capable of obtaining xylanases used in the present invention. Here again applicants are arguing the rejection as if it applied to the new claims they have presented and failed to address the lack of written description for claims 30-40.

In response to the rejection of claims 30-53 under 35 U.S.C. 102(b) and 103(a), applicants have traversed the rejections and again argued applying the rejection to the new claims they have now requested to be entered. Applicants basically argue that none of the

Art Unit: 1652

references used by the Examiner disclose or teach that the xylanases can be used in a animal feed,

“Significantly none of the cited references teach or suggest the use of thermostable xylanases in animal feed compositions or that there would be any advantage to using a thermostable xylanase over a thermolabile xylanase in animal feed”, page 7, 7th para.

Examiner respectfully disagrees with such an argument. As previous claims were not directed to an animal feed composition comprising the above xylanase, Examiner did not address the use of xylanase in animal feed. Examiner would have appropriately rejected or allowed based on the outcome of a search directed to the above subject matter if such claims were presented earlier. Presenting new claims at this stage in the prosecution of the application and arguing that the previous rejection does not apply is not persuasive to overcome the previous rejections.

Applicants also submit that they will file a terminal disclaimer to overcome the double patenting rejection of claims 30-53. However, as applicants have not yet filed such a disclaimer, rejection of claims 30-53 under double patenting paragraphs is maintained.

Therefore for all the above reasons, all previous rejections of claims 30-53 are maintained and the newly filed amendment has not been entered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone

Application/Control Number: 09/467,368

Page 4

Art Unit: 1652

numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.

Manjunath N. Rao
December 9, 2002

Rebecca P. Scott
REBECCA P. SCOTT
PRIMARY EXAMINER
~~GROUP 1000~~
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